



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/598,460

08/31/2006

Steven M. Palay

940131.413USPC

5763

500

7590

09/23/2010

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC

701 FIFTH AVE

SUITE 5400

SEATTLE, WA 98104

EXAMINER

SPAR, ILANA L

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

09/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/598,460	Applicant(s) PALAY ET AL.	
	Examiner ILANA SPAR	Art Unit 2629	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 22,51,53-60,62-67.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Bipin Shalwala/
Supervisory Patent Examiner, Art Unit 2629

Continuation of 11. does NOT place the application in condition for allowance because: Examiner disagrees with Applicant's arguments that Yamanami et al. (US Patent 4,902,858) fails to teach each and every limitation of claims 22, 51, 53-60 and 62-67. Applicant argues on pages 2-3 that Yamanami specifically does not teach determining the pen position using the signal generated by the surface; however, Examiner points to column 1, line 55 to column 2, line 16, which teaches that a signal is transmitted from the surface, received by the pen, and the pen then transmits a signal back to the position resolving grid based on the received signal from the surface which allows the position resolving grid to determine the location of the pen ("detection of the position and operating status of the position designating devices"). Because Yamanami teaches that the surface is able to detect both a position and an operating status of the device, it would be clear that the position resolving portion of the surface would detect the position, while the additional receiving portion of the surface may detect the operating status, for example, which "color" pen is being used. Therefore, Yamanami both teaches that the surface (i.e. the position resolver) detects the position of the pen, as described in columns 1-2 and as would be expected to do based on its intended purpose, and also teaches that the transducer receives a signal from the surface and transmits a signal in response to it, again as described in the cited portions of columns 1-2. As to Applicant's second argument, that Yamanami fails to teach that the plurality of overlapping transmission coils are resonant power transmission coils, Examiner respectfully disagrees. Applicant argues that the definition of a resonant power transmission coil as applied to the claims has a particular meaning, as set out in the specification. However, this particular meaning is not explicitly set out in the claims, nor is it even implicitly known as the standard definition of the term "resonant circuit." Yamanami also discusses a resonant circuit (see column 5, resonant circuit 22), but teaches that the resonant circuit is a circuit which resonates at a particular frequency. As Applicant has pointed out, this reference is additionally assigned to the same assignee as the present invention. Therefore, even within this particular company there are multiple definitions for the term "resonant circuit" and thus, without specifically explaining the type of resonant circuit intended within the claim limitation, it is not possible for the Examiner to know or definitively assign a particular definition to the term within the claim. The power transmission coils transmit at particular frequencies to correspond to the particular frequencies of the pen input devices, thus, the power transmission coils taught by Yamanami also are resonant power transmission coils, as specified in claim 22. Therefore, Examiner believes that the Yamanami reference teaches everything that it has previously been claimed to teach, and the claims in their current form are not patentable.